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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,847	12/04/2001	John C. Clark	57320US002	7827

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EXAMINER	
ROBERTSON, JEFFREY	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,847	CLARK ET AL.	
	Examiner	Art Unit	
	Jeffrey B. Robertson	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☒ Claim(s) *2-4,6,7 and 11-15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *0302*
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it is two paragraphs long. Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claims 14 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. For claim 14, the claim depends from itself. For examination purposes, the examiner has treated claim 14 as depending from claim 13.

3. Claims 2-4, 6, 7 and 11-15 are objected to because of the following informalities: For claim 2, the claim sets forth that it comprises "the further reaction product of an aliphatic monofunctional compound". However, the claim does expressly state whether this further reaction product is the reaction product of claim 1 that has been reacted with the monofuntional compound or whether the composition contains an additional reaction product of a monofuntional compound. If the latter is the case, what is the monofunctional compound reacted with to form the reaction product? For claim 11, "[t]he" in the first line of the claim should be changed to "A". Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-11,13,14,16, and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-9, 11-14, 19, and 24-26 of copending Application No. 10/124,523 in view of Smith et al. (U.S. Patent No. 5,350,795).

Claims 1 and 17 of the instant application disclose a urethane composition comprising the reaction product of an aliphatic polyisocyanate having three or more isocyanate groups and a fluorochemical having a sulfonamide linkage and a perfluoroalkyl group having from 3 to about 6 carbon atoms, where the fluorochemical is present in sufficient amount to react with at least about 50% of the available isocyanate groups. Claim 17 discloses the presence of a surfactant in this composition. Claims 1-3 of the '523 application disclose a composition comprising the reaction product of an aliphatic polyisocyanate having three or more isocyanate groups and a fluorochemical where the fluorochemical is present in sufficient amount to react with at least about 50% of the available isocyanate groups. Claims 1-3 also disclose the presence of a fluoroalkyl (meth)acrylate/polyoxyalkylene (meth)acrylate copolymer surfactant. Claims

2 and 3 disclose that the fluorochemical contains a perfluoroalkyl group having from 3 to about 6 carbon atoms and sulfonamide linkages. The compounds of claim 3 of the '523 application fall within the formula set forth in claim 1 of the instant application. Claim 17 of the instant application fails to teach the identity of the surfactant.

In column 4, lines 1-5, Smith teaches fluorochemical compositions including perfluoroalkyl group containing polyurethanes and surfactants made from fluorinated acrylates and polyalkylene glycol acrylates.

Smith, the instant application, and '523 are all analogous art because they come from the same field of endeavor, namely fluorinated urethane containing treatment compositions. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the surfactants taught in Smith as the surfactant claimed in claim 17. The motivation would have been that the instant claim 17 teaches a broad genus of surfactants. One of ordinary skill in the art would have turned to Smith for a specific surfactant used in similar compositions. Thus the claims of the instant application and the claims of the '523 application are not patentably distinct when in view of the Smith reference.

Claims 2, 3, 4, 6, 7, 8, 9, 10, 11, 13, 14, and 16 of the instant application and claims 4, 5, 7, 9, 11,12, 13, 14, 19, 24, 25, and 26 of the '523 application are identical, respectively.

Claim 5 of the instant application and claim 8 of the '523 application are essentially identical, the only difference being that claim 8 of '523 limits the carbon

atoms to from about 3 to 5, which is only one carbon less than claim 5 of the instant application.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 9, and 11-16 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/803,702 (US 2003/0026997 A1, Qiu et al.) which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application. For claims 1, 5, and 9, on page 27, paragraph [00369], Qiu teaches the reaction of $C_4F_9SO_2N(CH_3)CH_2CH_2OH$ with N-100 a triisocyanate in a ratio of 3/1, which would allow for the reaction of at least 50% of the available isocyanate groups. Note that the amount of carbon atoms of the perfluorinated group is four. For claims 2-4, on page 7, paragraphs [0092]-[0095], Qiu

teaches the presence of a fluorochemical moonofunctional compound that can be additionally reacted. This reaction would result in the compounds set forth in claim 4. For claims 11-13, 15, and 16, on pages 11-12 in paragraphs [0132]-[0135], Qiu teaches that a treatment composition is formed from the addition of a solvent where the amount of fluorochemical present is from 1-5% by weight. Here Qiu teaches that the treatment is applied and cured, which would form a coated article. In paragraph [0138], Qiu teaches that the composition can be cured at ambient temperature. For claim 14, in paragraph [0415], Qiu teaches that the level of solids on fiber is between 0.05 to 3%.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. De Vos et al. (U.S. Patent No. 5,484,818) and Jariwala et al. (US Patent No. 6,525,127) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR